REMARKS

A.   Examiner Interview Summary

In March 2009, Applicants representative, Mark Garrett, exchanged emails with Examiner Do about the current rejection. Mr. Garrett inquired whether the step of "acquiring a subject color medical image using an endoscope" (claim 27) was sufficiently tied to a particular machine (i.e., an endoscope) to meet the machine prong of *Bilski*, and the Examiner indicated it was. Mr. Garrett also inquired whether amending claims 10 and 17 such that the claimed actions are performed using a computer system specifically programmed for same satisfied the machine prong of *Bilski*. The Examiner indicated *Bilski* would be satisfied, but that the proposed amendment had a "single means" problem. Mr. Garrett proposed reciting that such a computer system were specifically programmed for only one of the actions, and the Examiner replied that *Bilski* would not be satisfied and that a "computer readable medium" would be required. Mr. Garrett also argued that there was no "single means" problem. The email exchanges are attached for reference. No agreement was reached.

B.   The *Bilski* Rejections Are Overcome.

The pending claims stand rejected under section 101. Claim 10 has been amended to recite "comparing a subject color medical image <u>acquired using an endoscope</u> to normal color medical image data;" and "<u>graphically</u> displaying the subject color medical image and highlighting areas of the subject color medical image that have a saturation that is greater than normal." (The underlined words having been added). As examined, the claim specified the "type or nature of data" (*In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008) (en banc)): a subject color medical image. And as amended, claim 10 now recites "how or where the data was obtained" (*id.*): acquired using an endoscope. Furthermore, it now explicitly recites a <u>graphical</u>

visual depiction of the image, which necessarily represents specific physical objects or substances, and therefore clearly includes a patent-eligible data transformation under *Bilski*. *Id.* ("So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.").

Claim 17 has been amended in a similar manner and is patent-eligible for similar reasons.

Claim 27 satisfies the machine prong in its examined form, as the Examiner acknowledged, because it recites "acquiring a subject color medical image using an endoscope" and therefore is sufficiently tied to an endoscope.

C.   The New Claims Satisfy *Bilski*.

New claim 34 is identical to examined claim 10, and further recites that "the comparing, the identifying, the displaying, and the highlighting are performed using a computer system specifically programmed for the comparing, the identifying, the displaying, and the highlighting." New claim 35 is identical to examined claim 17, and further recites that "the displaying, the comparing, and the highlighting are performed using a computer system specifically programmed for the displaying, the comparing, and the highlighting." As Examiner Do indicated during the email exchange attached to this response, these additional recitations sufficiently tie these claims to a particular machine to satisfy the machine prong of *Bilski*.

The Examiner has indicated that these claims would, however, face a "single means" problem. Applicants respectfully disagree. The Board decision in *Ex parte Wilson*, Appeal No. 2008-0668, slip op. at 4-6 (BPAI Aug. 19, 2008) (non-precedential) is instructive on this point. In *Wilson*, the Applicant pointed out that a claim rejected on "single means" grounds was not

drafted in means plus function format, as required by MPEP 2164.08(a) and *In re Hyatt*. The

Board agreed and reversed the single means rejection. The Board explained:

> The Examiner responds that "claim 10 is rejected not based on whether it is means plus function. Claim 10 is rejected because it is a single means claim." (Ans. 8). Appellants respond, in turn, that "*In re Hyatt* and MPEP 2164.08(a) explicitly define a single means claim as being a claim in means plus function form but reciting only a single element instead of a combination." (Reply. Br. 6).

> We agree with Appellants. For the issue at hand, *In re Hyatt* applies to single element claims in means plus function format. In other words, the MPEP and the decision of *In re Hyatt* references to "single means" claims are simply short-hand for "means plus function" claims having only one element:

>> The final paragraph of § 112 saves combination claims drafted using means-plus-function format from this problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a combination, i.e., a single means claim.

> [*In re Hyatt*, 708 F.2d 712, 715 (Fed. Cir. 1983)].

> As the Examiner acknowledges that claim 10 is not in "means plus function" form, and we determine that the Examiner is correct in that regard, it follows that claim 10 is not a "single means" claim. Accordingly, as the Examiner bases the rejection on the determination that claim 10 is a "single means" claim, the Examiner has failed to establish a prima facie case of lack of enablement or undue breadth.

Wilson, slip op. at 5-6.

We have effectively the same situation here. Claims 34 and 35 are method claims with

multiple steps. While some of those steps are claimed as being "performed using a computer

system specifically programmed for [them,]" this claim language does not use the term "means

for," nor does the claim as a whole otherwise fit the definition of a single means claim set forth

in *In re Hyatt* and the MPEP. Further, the present specification states on page 73, lines 12-15:

"The appended claims are not to be interpreted as including means-plus-function limitations,

unless such a limitation is explicitly recited in a given claim using the phrase(s) 'means for'

and/or 'step for,' respectively." This is another reason that the claims are not in means-plus-

function format.

Accordingly, Applicants submit that new claims 34 and 35 do not violate the "single means" doctrine of *In re Hyatt*.

D. Conclusion

Applicants submit that this application is now in condition for allowance. Should Examiner Do have any questions, comments, or suggestions relating to this application, he is invited to contact Applicants' attorney at (512) 536-3031.

Date: April 22, 2009   Respectfully submitted,

                                        /Mark T. Garrett/

FULBRIGHT & JAWORSKI L.L.P.   Mark T. Garrett
600 Congress Avenue, Suite 2400   Reg. No. 44,699
Austin, Texas   78701   Attorney for Applicants
Telephone: (512) 536-3031
Facsimile: (512) 536-4598

From:	Garrett, Mark
Sent:	Thursday, March 05, 2009 8:09 PM
To:	'Do, Anh'
Subject:	RE: Ser. No. 10/777,764

Examiner Do, thank you for the reply.

What if I only recited the computer system with respect to the highlighting? Claims 10 and 17 would therefore read:

10.   (currently amended) A method comprising:

comparing a subject color medical image to normal color medical image data;

identifying abnormal pixels from the subject color medical image; and

displaying the subject color medical image and highlighting areas of the subject color medical image that have a saturation that is greater than normal;

where the highlighting is performed using a computer system specifically programmed for the highlighting.

17.   (currently amended) A method comprising:

displaying a subject color medical image;

comparing the subject color medical image to normal color medical image data to identify abnormal pixels from the subject color medical image; and

highlighting abnormal pixels on the displayed subject color medical image;

where the highlighting includes highlighting areas of the displayed subject color medical image that have a saturation that is greater than normal, and the highlighting is performed using a computer system specifically programmed for the highlighting.

Thank you for your consideration.

Mark Garrett

-----Original Message-----
From: Do, Anh [mailto:Anh.Do@USPTO.GOV]
Sent: Thursday, March 05, 2009 7:37 PM
To: Garrett, Mark
Subject: RE: Ser. No. 10/777,764

Mr. Mark Garrett,

Claims 10 and 17 are tied to a particular machine. However, they run into another problem with single means (i.e., a single component performs all the steps).

The step of "acquiring a subject color medical image using an endoscope" is sufficiently tied to a particular machine.

Thanks for a proposed amendment.

Anh Do

From: Garrett, Mark [mailto:mgarrett@fulbright.com]
Sent: Thursday, March 05, 2009 7:50 PM
To: Do, Anh
Subject: Ser. No. 10/777,764

Hello Examiner Do,

Would you review the following amendments and let me know whether they would overcome the 101 rejections?:

10. (currently amended) A method comprising:

comparing a subject color medical image to normal color medical image data;

identifying abnormal pixels from the subject color medical image; and

displaying the subject color medical image and highlighting areas of the subject color medical image that have a saturation that is greater than normal;

where the comparing, the identifying, the displaying, and the highlighting are performed using a computer system specifically programmed for the comparing, the identifying, the displaying, and the highlighting.

17. (currently amended) A method comprising:

displaying a subject color medical image;

comparing the subject color medical image to normal color medical image data to identify abnormal pixels from the subject color medical image; and

highlighting abnormal pixels on the displayed subject color medical image;

where the highlighting includes highlighting areas of the displayed subject color medical image that have a saturation that is greater than normal; and

where the displaying, the comparing, and the highlighting are performed using a computer system specifically programmed for the displaying, the comparing, and the highlighting.

Please also consider whether the step of "acquiring a subject color medical image using an endoscope" is sufficiently tied to a particular machine (i.e., an endoscope) to meet the machine portion of the Bilski 101 test. I noticed that you did not reference the endoscope in your Action, and believe it may have been overlooked.

Thank you for your time.

Respectfully,

Mark Garrett
512.536.3031

Garrett, Mark

Mr. Mark Garett,

If you believe claims 10 and 17 in your proposed amendment are not "single means claims" please officially submit the proposed amendment for consideration. Via e-mail, we are not allowed to discuss in details about this issue. Thank you.

Best Regards,

Anh Do

-----Original Message-----
From: Garrett, Mark [mailto:mgarrett@fulbright.com]
Sent: Monday, March 30, 2009 1:00 PM
To: Do, Anh
Subject: New Email Re: Ser. No. 10/777,764

Examiner Do, I wanted to make sure you know that the 26 March email below is a new one, in case it escaped your attention.

I look forward to your response.

Respectfully,

Mark Garrett
512.536.3031

-----Original Message-----
From: Garrett, Mark
Sent: Thursday, March 26, 2009 6:55 PM
To: 'Do, Anh'
Subject: RE: Ser. No. 10/777,764

Examiner Do,

I have carefully considered the single means issue you raised below, and submit the following:

The Board decision in Ex parte Wilson, Appeal No. 2008-0668, slip op. at 4-6 (BPAI Aug. 19, 2008) (non-precedential) is instructive on this point. In Wilson, the Applicant pointed out that a claim rejected on "single means" grounds was not drafted in means plus function format, as required by MPEP 2164.08(a) and In re Hyatt.

The Board agreed and reversed the single means rejection. Here is what the Board said:

The Examiner responds that "claim 10 is rejected not based on whether it is means plus function. Claim 10 is rejected because it is a single means claim." (Ans. 8). Appellants respond, in turn, that "In re Hyatt and MPEP 2164.08(a) explicitly define a single means claim as being a claim in means plus function form but reciting only a single element instead of a combination." (Reply. Br. 6).

We agree with Appellants. For the issue at hand, In re Hyatt applies to single element claims in means plus function format. In other words, the MPEP and the decision of In re Hyatt references to "single means" claims are simply short-hand for "means plus function" claims having only one element:

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The final paragraph of § 112 saves combination claims drafted using means-plus-function format from this problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a combination, i.e., a single means claim.

[In re Hyatt, 708 F.2d 712, 715 (Fed. Cir. 1983)].

As the Examiner acknowledges that claim 10 is not in "means plus function" form, and we determine that the Examiner is correct in that regard, it follows that claim 10 is not a "single means" claim. Accordingly, as the Examiner bases the rejection on the determination that claim 10 is a "single means" claim, the Examiner has failed to establish a prima facie case of lack of enablement or undue breadth. fn1

fn1 We do not imply that only single means claims can run afoul of the scope of enablement prohibition.

We have effectively the same situation here.

Claims 10 and 17 are method claim with multiple steps. And while some of those steps are, in the amendment I propose, claimed as being "performed using a computer system specifically programmed for [them]", this claim language does not use the term "means for," nor does the claim as a whole otherwise fit the definition of a single means claim set forth in In re Hyatt and the MPEP.

Further, the present specification states on page 73, lines 12-15: "The appended claims are not to be interpreted as including means-plus-function limitations, unless such a limitation is explicitly recited in a given claim using the phrase(s) 'means for' and/or 'step for,' respectively." This is another reason that the claims are not in means-plus-function format.

Accordingly, I submit that the amended version of claims 10 and 17 would not violate the "single means" doctrine of In re Hyatt.

Please advise, and thank you for your consideration.

Respectfully,

Mark Garrett
512.536.3031

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Claims 10 and 17 are tied to a particular machine. However, they run into another problem with single means (i.e., a single component performs all the steps).

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where the comparing, the identifying, the displaying, and the highlighting are performed using a computer system specifically programmed for the comparing, the identifying, the displaying, and the highlighting.

17.   (currently amended) A method comprising:

displaying a subject color medical image;

comparing the subject color medical image to normal color medical image data to identify abnormal pixels from the subject color medical image; and

highlighting abnormal pixels on the displayed subject color medical image;

where the highlighting includes highlighting areas of the displayed subject color medical image that have a saturation that is greater than normal; and

where the displaying, the comparing, and the highlighting are performed using a computer system specifically programmed for the displaying, the comparing, and the highlighting.

Please also consider whether the step of "acquiring a subject color medical image using an endoscope" is sufficiently tied to a particular machine (i.e., an endoscope) to meet the machine portion of the Bilski 101 test. I noticed that you did not reference the endoscope in your Action, and believe it may have been overlooked.

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